11 Req. for Reconsid. Hawkins 6-24-02

UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: Pedro J. Cuevas *Art Unit:* 2834

In re:

Applicant: Klaus-Peter Schmoll

Serial No.: 09/763,254

Filed: April 5, 2001

AMENDMENT

June 19, 2002

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

This communication is responsive to the Office Action of May 2, 2002.

In the Office Action the Examiner rejected claims 1-4 and 6-8 under 35 U.S.C. 103(a) over the U.S. patent to Hanafy in view of the U.S. patent to Issartel.

Claim 5 is rejected under 35 U.S.C. 103 over the above identified references and further in view of the common knowledge in the art.

With the present communication applicants have retained the claims as they were. It is respectfully submitted that the new features of the present invention which are now defined in claim 1, the broadest claim on file, are not disclosed in the references and can not be derived from them as a matter of obviousness.

In his rejection of the present application, the Examiner made a comparison between a sound generator and an actuator. This comparison is not justified since these two different objects can not be compared with one another and are not similar in any way.

The Examiner did not take into consideration that an actuator serves for transmission of forces and not for formation of sound waves as in the case of the sound generator. He did not take into consideration that as

defined in claim 1 with the claimed shape of the multi layered structure of the actuator during axial clamping a stress is produced. This is not disclosed in the prior art. In contrast, during the operation the desired slope must be maintained, no stressing is generated.

It is therefore believed to be clear that the patent to Hanafy discloses an ultrasound transducer which has nothing to do with the piezo electric actuator in accordance with the present invention.

As for the patent to Issartel it discloses the actuator only as a starting point of the object of the present invention; however it does not teach the new features of the present invention which are now defined in the claims. It is believed that the references can not be combined as a matter of obviousness. Also, it should be emphasized that the patent to Hanafy belongs to non-analogous art.

In connection with this, the Examiner's attention is respectfully directed to the decision of the Court of Customs and Patent Appeals in re Lobl Case as reported in 108 USPQ 229, where this question was firmly settled with respect to the use of non-analogous art that:

> "No withstanding difference in functions patent in non analogous art would be proper reference if it disclosed all the structure setforth in applicant's claims. However; rejection may not be based upon modification's structure in view of another patent in non analogous art; such references may not be combined to form basis for rejection since it is unlikely that one seeking to produce applicant's device would look to such non analogous art for suggestions".

In view of the above presented remarks and amendments, it is believed that claim 1 together with other claims should be considered as patentably distinguishing over the art and should be allowed.

Reconsideration and allowance of present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Any costs involved should be charged to the deposit account of the undersigned (No. 19-4675). Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

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